

O/0815/26

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF TRADE MARK APPLICATION NUMBERS UK00003966592,
UK00003966590 AND UK00003968182
BY MASCOT PETS LTD

AND OPPOSITIONS THERETO UNDER NUMBERS 445479, 445480 AND 445481
BY SHEIKH TANVIR MOHAMMED KHALED

AND

IN THE MATTER OF TRADE MARK APPLICATION NUMBERS UK00003953437
AND UK00003976381
BY SHEIKH TANVIR MOHAMMED KHALED

AND OPPOSITIONS THERETO UNDER NUMBERS 444935 AND 446219
BY MASCOT PETS LTD

BACKGROUND AND PLEADINGS

The applications by Khaled Tanvir Mohammed Khaled

1. On 5 September 2023, Sheikh Tanvir Mohammed Khaled (hereafter referred to as “Khaled”) filed application number UK00003953437 to register the trade mark “Oldgitamol” (hereafter referred to as “Khaled’s Oldgitamol Class 16 application”). The application was published for opposition purposes on 29 September 2023 and registration is sought for the following goods:

Class 16: Cards; Christmas gift wrap; Gift wrap; Diaries; Pocket diaries; Gift wrapping paper; Greeting cards; Invitation cards; Invitations; Party invitations; Printed invitations; Notepads; Paper; Paper party bags; Paper bags; Paper boxes; Paper boxes for storing greeting cards; Paper pads; Pen and pencil boxes; Pen and pencil cases; Pen boxes; Pencil boxes; Pen sets; Pens; Pencils; Pencil sets; Postcard paper; Postcards; Printed cards; Thank you cards; Writing paper; Writing paper pads; Printed packaging materials of paper; Packaging materials; Gift packaging; Cardboard packaging; Paper bags for packaging; Origami folding paper; Gift boxes; Cardboard gift boxes; Paper gift boxes; Gift bags; Gift cards; Gift certificates; Printed paper invitations; Graphic prints.

2. On 7 November 2023, Khaled filed application number UK00003976381 to register the trade mark “Oldgitamol” (hereafter referred to as “Khaled’s Oldgitamol Class 30 application”). The application was published for opposition purposes on 8 December 2023 and registration is sought for the following goods:

Class 30: Sweets; Candies [sweets]; Sweets [candy]; Chocolate sweets; Sugar-free sweets; Caramels [sweets]; Sugarfree sweets; Sugarless sweets; Peppermint sweets; Sweets (Peppermint -); Sweets (Non-medicated -) being acidulated caramel sweets; Gum sweets; Sweetmeats being candies; Boiled sweets; Sweetmeats [candy]; Non-medicated sweets; Sweets (Non-medicated -); Sweets (Non-medicated -) in the nature of sugar confectionery; Sweetmeats [candy] being flavoured with fruit; Xylitol-sweetened sweets; Foamed sugar sweets; Sweets (Non-medicated -) in the nature of chocolate eclairs; Sweets (Non-medicated -) in the nature of toffees; Peppermint

sweets [other than for medicinal use]; Gum sweets (Non-medicated -); Mint-based sweets; Sweets (candy), candy bars and chewing gum; Chocolate candies; Chewing sweets (Non-medicated -); Mint flavoured sweets (Non-medicated -); Sweets (Non-medicated -) in the nature of caramels; Lollipops [confectionery]; Candies; Sweetmeats [candy] containing fruit; Sweets (Non-medicated -) being acidulated; Caramels [candies]; Sweets (Non-medicated -) in the nature of fudge; Sherbets [confectionery]; Sugarless candies; Chocolate-coated sugar confectionery; Sweets (Non-medicated -) in the nature of nougat; Chocolate confections; Chocolate confectionery; Chocolate candy with fillings; Chocolates; Sugar candy [for food]; Sugar confectionery; Flavoured sugar confectionery; Chewing sweets (Non-medicated -) having liquid fruit fillings; Jellies (Fruit -) [confectionery]; Fruit jellies [confectionery]; Sugar candies (Non-medicated -); Sugar-free mint candies; Fruit confectionery; Chocolate confectionery; Non-medicated confectionery candy; Caramels [candy]; Mint based sweets [non-medicated]; Sweets (Non-medicated -) being honey based; Sherbet [confectionery]; Candy [sugar]; Chocolate confectionery containing pralines; Pastilles [confectionery]; Chocolate confectionery products; Confectionery chocolate products; Gummy candies; Confectionery; Non-medicated chocolate confectionery; Truffles [confectionery]; Peppermint for confectionery; Milk chocolates; Candy coated confections; Candy; Mints [candies, non-medicated]; Candy mints; Chocolate confectionery having a praline flavour; Toffees; Breath-freshening chewing gum; Bubble gum; Bubble gum [confectionery]; Chewing gum; Chewing gums; Sugar-free chewing gum; Sugarfree chewing gum; Sugarless chewing gum.

The oppositions by Mascot Pets Ltd

3. On 28 December 2023, Mascot Pets Ltd (hereafter referred to as “Mascot”) filed an opposition (no. 444935) against the entirety of Khaled’s Oldgitamol Class 16 application, based upon sections 5(4)(a) and 3(6) of the Trade Marks Act 1994 (“the Act”).

4. Under section 5(4)(a), Mascot relies upon the unregistered sign “OLDGITAMOL”, which it claims to have used in the UK since 3 May 2023 in relation to *paper boxes* and *giftboxes*. Mascot claims to have generated goodwill in the sign and claims that use of Khaled’s Oldgitamol Class 16 application would constitute a misrepresentation

to the public that would damage Mascot's goodwill. Therefore, use of Khaled's Oldgitamol Class 16 application would be contrary to the law of passing off.

5. Under section 3(6), Mascot claims that Khaled was aware of Mascot's use of the sign "OLDGITAMOL" and that the purpose of Khaled's Oldgitamol Class 16 application was to restrict Mascot's use of the mark on the same product. Mascot also claims that Khaled has filed several trade mark applications identical to marks owned by Mascot. Consequently, it is claimed that Khaled's Oldgitamol Class 16 application was applied for in bad faith.

6. Khaled filed a counterstatement denying the grounds of opposition.

7. On 5 March 2024, Mascot filed an opposition (no. 446219) against the entirety of Khaled's Oldgitamol Class 30 application, based upon sections 5(1) and 5(2)(a) of the Act. Mascot relies upon trade mark number UK00003968182, "Oldgitamol", (hereafter referred to as "Mascot's Oldgitamol Class 30 application") which was filed on 17 October 2023 and published on 3 November 2023 in relation to the following goods:

Class 30: Candy; sweets; sugar confectionary; boiled sweets; bubble gum; candy bars; confectionary; chocolate; sherbets; sorbets; flavouring syrup.

8. On account of it having an earlier filing date than that of Khaled's Oldgitamol Class 30 application, Mascot's Oldgitamol Class 30 application is an earlier trade mark in accordance with section 6(1)(a) of the Act. However, the registration procedure for the earlier mark has not been completed and so the use provisions set out in section 6A of the Act do not apply; Mascot may (subject to an opposition against this mark by Khaled, which I will address in due course) rely upon its Oldgitamol Class 30 application without needing to demonstrate genuine use.

9. Under section 5(1), Mascot claims that the parties' respective Oldgitamol Class 30 applications are for identical trade marks and identical goods. Under section 5(2)(a), Mascot claims that the parties' respective Oldgitamol Class 30 applications are for identical trade marks and similar goods, resulting in a likelihood of confusion.

10. Khaled filed a counterstatement denying the grounds of opposition.

The applications by Mascot

11. On 12 October 2023, Mascot filed application number UK00003966592 to register the trade mark “Oldgitamins” (hereafter referred to as “Mascot’s Oldgitamins Class 16 application”). The application was published for opposition purposes on 27 October 2023 and registration is sought for the following goods:

Class 16: Cards; Christmas gift wrap; Gift wrap; Diaries; Pocket diaries; Gift wrapping paper; Greeting cards; Invitation cards; Invitations; Party invitations; Printed invitations; Notepads; Paper; Paper party bags; Paper bags; Paper boxes; Paper boxes for storing greeting cards; Paper pads; Pen and pencil boxes; Pen and pencil cases; Pen boxes; Pencil boxes; Pen sets; Pens; Pencils; Pencil sets; Postcard paper; Postcards; Printed cards; Thank you cards; Writing paper; Writing paper pads; Printed packaging materials of paper; Packaging materials; Gift packaging; Cardboard packaging; Paper bags for packaging; Origami folding paper; Gift boxes; Cardboard gift boxes; Paper gift boxes; Gift bags; Gift cards; Gift certificates; Printed paper invitations; Graphic prints.

12. On 12 October 2023, Mascot filed application number UK00003966590 to register the trade mark “Oldgitamol” (hereafter referred to as “Mascot’s Oldgitamol Class 16 application”). The application was published for opposition purposes on 27 October 2023 and registration is sought for the following goods:

Class 16: Cards; Christmas gift wrap; Gift wrap; Diaries; Pocket diaries; Gift wrapping paper; Greeting cards; Invitation cards; Invitations; Party invitations; Printed invitations; Notepads; Paper; Paper party bags; Paper bags; Paper boxes; Paper boxes for storing greeting cards; Paper pads; Pen and pencil boxes; Pen and pencil cases; Pen boxes; Pencil boxes; Pen sets; Pens; Pencils; Pencil sets; Postcard paper; Postcards; Printed cards; Thank you cards; Writing paper; Writing paper pads; Printed packaging materials of paper; Packaging materials; Gift packaging; Cardboard packaging; Paper bags for packaging; Origami folding paper; Gift boxes; Cardboard

gift boxes; Paper gift boxes; Gift bags; Gift cards; Gift certificates; Printed paper invitations; Graphic prints.

13. On 17 October 2023, Mascot applied for its Oldgitamol Class 30 application, referred to at paragraph 7 of this decision as the mark relied upon in the opposition against Khaled's Oldgitamol Class 30 application.

The oppositions by Khaled

14. On 24 January 2024, Khaled filed an opposition (no. 445479) against the entirety of Mascot's Oldgitamins Class 16 application, based upon section 5(2)(b) of the Act. Khaled relies upon its Oldgitamol Class 16 application (set out at paragraph 1 of this decision).

15. Under section 5(2)(b), Khaled claims that the parties' respective Oldgitamins and Oldgitamol Class 16 applications are for similar trade marks and identical goods, resulting in a likelihood of confusion.

16. On 24 January 2024, Khaled filed an opposition (no. 445480) against the entirety of Mascot's Oldgitamol Class 16 application, based upon section 5(1) of the Act. Khaled relies upon its Oldgitamol Class 16 application.

17. Under section 5(1), Khaled claims that the parties' respective Oldgitamol Class 16 applications are for identical trade marks and identical goods.

18. On 24 January 2024, Khaled filed an opposition (no. 445481) against the entirety of Mascot's Oldgitamol Class 30 application, based upon section 5(2)(a) of the Act. Khaled relies upon its Oldgitamol Class 16 application.

19. Under section 5(2)(a), Khaled claims that the parties' respective Oldgitamol Class 30 and Class 16 applications are for identical trade marks and similar goods, resulting in a likelihood of confusion.

20. On account of it having an earlier filing date than that of Mascot's Oldgitamins Class 16 application and Mascot's Oldgitamol Class 16 and Class 30 applications, Khaled's Oldgitamol Class 16 application, relied upon in the three aforementioned oppositions, is an earlier trade mark in accordance with section 6(1)(a) of the Act. However, the registration procedure for the earlier mark has not been completed and so the use provisions set out in section 6A of the Act do not apply; Khaled may (subject to the opposition set out at paragraphs 3 to 5 of this decision) rely upon its Oldgitamol Class 16 application without needing to demonstrate genuine use.

21. Mascot filed a counterstatement in each of the three aforementioned oppositions, denying the entirety of the grounds.

Consolidation

22. On 22 April 2024 and 3 June 2024, the parties were notified in writing that the above five oppositions would be consolidated, in accordance with Rule 62(1)(g) of the Trade Marks Rules 2008.

Representation

23. Mascot has been represented throughout these proceedings by Dynham. Khaled was unrepresented until the main hearing, for which Counsel was instructed.

Evidence and submissions

24. Khaled filed evidence in chief in the form of the first witness statement in his own name ("SK WS1") dated 5 August 2024 and its corresponding four exhibits ("SK1 – SK4").

25. Mascot filed evidence in chief in the form of the first witness statement of Stephen Edward James ("SEJ WS1") dated 5 August 2024 and its corresponding 16 exhibits ("SEJ1 – SEJ16"). Stephen Edward James is the Director of Mascot.

26. Khaled filed evidence in reply in the form of his second witness statement (“SK WS2”) dated 7 October 2024 and its corresponding nine exhibits (“SK2.1 – SK2.9”).

27. Mascot filed evidence in chief in the form of the second witness statement of Stephen Edward James (“SEJ WS2”) dated 7 October 2024 and its corresponding 23 exhibits (“SEJ17 – SEJ39”).

28. I do not intend to summarise the evidence here but have taken it into account and will refer to it throughout this decision, where relevant.

The Hearing

29. A hearing took place before me on 25 June 2025. Mascot was represented by Aaron Wood, instructed by Dynham. Khaled was represented by Counsel, Mr Gurmair Singh of JSC Chambers, instructed by direct access.

DECISION

Relevance of EU law

30. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. This is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

My approach

31. The opposition (no. 444935) by Mascot against Khaled’s Oldgitamol Class 16 application will determine the validity of the earlier mark relied upon by Khaled in each of its oppositions against Mascot’s applications. Accordingly, I will begin by deciding opposition no. 444935; depending on its success, I will then determine Khaled’s oppositions against Mascot’s three applications. The outcome of one of those

oppositions (no. 445481) will determine the validity of the earlier mark relied upon by Mascot in its opposition (no. 446219) against Khaled's Oldgitamol Class 30 application, and so, if necessary, this opposition will be decided last.

Opposition no. 444935 against Khaled's Oldgitamol Class 16 application

Section 5(4)(a)

Statutory provisions

32. Section 5(4)(a) states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

33. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

Relevant case law

34. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy High Court judge, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a *substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

Relevant date

35. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Mr Daniel Alexander KC, as the Appointed Person, endorsed the registrar’s assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether

the position would have been any different at the later date when the application was made.”

36. Khaled’s narrative evidence states that he started trading in 2018,¹ however, there is no evidence of use of “Oldgitamol” by Khaled prior to the filing date. Consequently, I have only the prima facie relevant date to consider, which is 5 September 2023.

Goodwill

37. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

38. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd.’s Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation;

¹ SK WS1 at [3].

evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

39. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

40. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in *BALI Trade Mark* [1969] R.P.C. 472. The whole

point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

41. Turning to Mascot’s evidence of use, I remind myself that Mascot must demonstrate the requisite goodwill by 5 September 2023 and that it claims to have first used the sign “OLDGITAMOL” in the UK on 3 May 2023.

42. Products in the form of paper boxes featuring “OLDGITAMOL” were first available on Amazon on 3 May 2023,² with the listing being published and searchable from 16 June 2023.³ Between 1 June 2023 and 31 August 2023, there had been a total number of sales of “OLDGITAMOL” products of 1661, generating £9,949.39 of revenue.⁴ I have discounted September sales on the basis that I cannot determine the proportion that would be attributable to the period prior to the relevant date: (a) that period constitutes just four days; (b) the only September sales featured in evidence are dated 30 September 2023; and (c) there is no breakdown of sales for that month.

43. The aforementioned sales show a wide geographical spread across the UK⁵ and resulted in a number of positive reviews,⁶ as well as the product receiving ‘best seller’ status on Amazon in August 2023.⁷ However, when considering that goodwill distinguishes old businesses from new ones at their first start (*Inland Revenue*) the short period of custom shown in evidence points to a new business and not one which has built up goodwill. Whilst goodwill can be protectable even if minimal,⁸ the sales figures here are particularly low and the use far from longstanding (just three months).

² SEJ2, page 36.

³ SEJ WS1 at [4].

⁴ SEJ WS1 and SEJ3.

⁵ SEJ4.

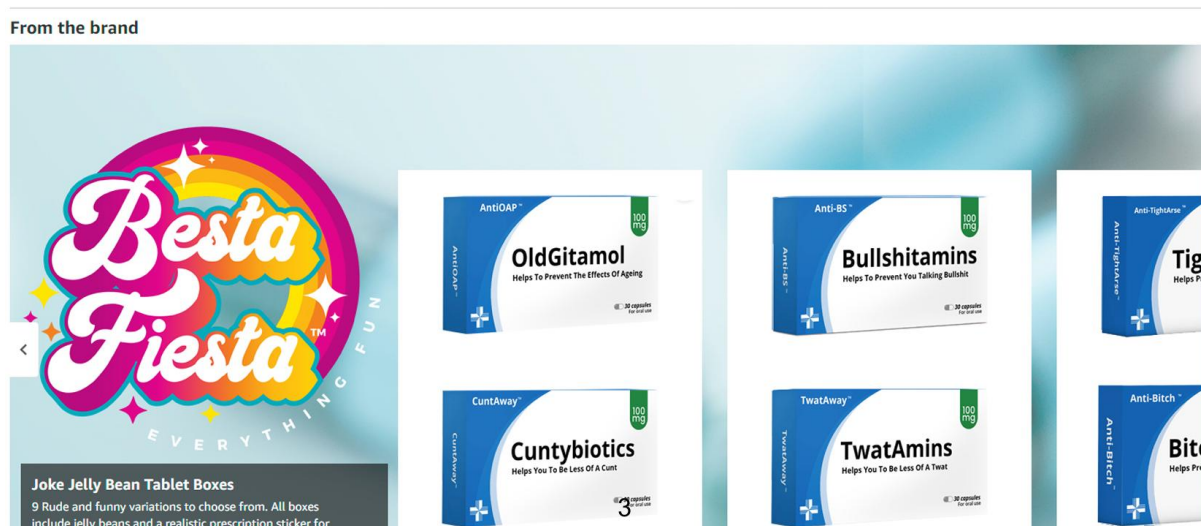
⁶ SEJ8.

⁷ SEJ5-7.

⁸ See *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590.

At the relevant date, I am not satisfied that there was any goodwill in the sign “OLDGITAMOL”.

44. Even if I am wrong and the use constitutes a minimal level of goodwill, there is no evidence that suggests to me that the relevant public would associate the “OLDGITAMOL” sign with Mascot. The only evidence showing the sign and being visible to the public is the printouts of the Amazon webpages.⁹ Under the heading “Product information”, the “Brand” and “Manufacturer” are listed as “BestaFiesta”. The customer review pages also include “by BestaFiesta” under the product name.¹⁰ The bottom of each of the product pages, under the heading “From the brand” (which purports to show other available products from the same brand), appears as follows:



45. Aside from printouts of Mascot’s Amazon seller pages (featuring “Mascot Pets United Kingdom”)¹¹ – which are pages not visible to the public since viewing them requires logging into the seller account – there is no evidence linking the products bearing the “OLDGITAMOL” sign to Mascot. In fact, the evidence suggests that the relevant public would associate “OLDGITAMOL” products with ‘Besta Fiesta’.

⁹ SEJ2 and SEJ8.

¹⁰ SEJ8, page 154.

¹¹ SEJ3 and SEJ4.

46. Having in mind that the sign being relied upon must be distinctive of and/or associated with the business claiming to own the goodwill,¹² I am not satisfied that even if there is a protectable level of goodwill (my primary finding being that there is not), Mascot has demonstrated that it owns or is associated with the requisite goodwill in the sign “OLDGITAMOL”.

Outcome

47. The section 5(4)(a) ground is dismissed.

Section 3(6)

Statutory provisions

48. Section 3(6) states:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

Relevant case law

49. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors* (Rev1) [2024] UKSC 36, Lord Kitchin summarised the general principles applicable to bad faith at [240] as follows:

“(i) [...]

(ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (Lindt, para 35).

¹² *AG Spalding & Bros v AW Gamage Ltd* [1915] 32 RPC (HOL). See also *T Oertli, AG v EJ Bowman (London) Ltd* (No.3) [1959] RPC 1 (HOL).

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation [...], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 ([*Malaysia Dairy Industries Pte Ltd v Ankenaevenet for Patenter og Varemaerker* (C-320/12) EU:C:2013:435 (“*Malaysia Dairy*”)], para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 (“*Sky CJEU*”)], para 73).

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the [...] law of trade marks, namely the establishment and functioning of [...] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; [*Koton Mağazacılık Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office* (EUIPO) (C-104/18) EU:C:2019:724 (“*Koton*”)], para 45).

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case ([*Hasbro Inc v EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 (“*Hasbro*”)], paras 39 and 40; *Koton*, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (*Lindt*, para 37).

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky CJEU*, para 76; [*AS v Deutsches Patent-und Markenamt* (C-541/18) EU:C:2019:725], para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/104 (*Sky CJEU*, para 77).

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

(xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to the goods or services in relation to which it is sought to register the mark, or that the applicant has a bona fide intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (*Sky CJEU*, paras 86 and 87)."

50. According to *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are:

(a) What, in concrete terms, was the objective that the applicant (Khaled) has been accused of pursuing?

(b) Was that an objective for the purposes of which the contested application could not be properly filed? and

(c) Was it established that the contested application was filed in pursuit of that objective?

51. It is necessary to ascertain what Khaled knew at the relevant date: *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others*, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16).

What, in concrete terms, was the objective that Khaled has been accused of pursuing?

52. In its statement of grounds, Mascot states as follows:

“[Mascot] has been using the mark “OLDGITAMOL” (the Contested Mark) on paper boxes and gift boxes with candy such as jelly beans inside since 3 May 2023 in the UK. On the Opponent’s Amazon listing which will be tendered into evidence at the later stage, shows a timestamp ‘Date First Available’ of 3 May 2023. It is an unusual name which was invented by the Opponent, particularly in the context of paper boxes with candy inside.

On 3 Sept 2023 [Khaled] filed the Contested Mark in an attempt to obtain a monopoly over the name, and presumably to restrict [Mascot] from using the name. [Khaled] has already used the Contested Mark as a basis to oppose [Mascot’s] UK Application for its mark UK00003966590 in Class 16 (Opposition No. OP000445480). One month later, on 1 Oct 2023, [Khaled] started selling a similar gift box design with chewing gum with an identical mark on Amazon UK, and two days later on 3 Oct 2023 [Khaled] also started selling a similar gift box with jelly beans with “OLDGITAMOL” on Amazon UK.

The registration of the Contested Mark will result in confusion and deception in the minds of the relevant customers; and/or enable [Khaled] to stop [Mascot] from using the mark for the relevant goods; and/or trigger a connection in the minds of the relevant customers between [Mascot’s] goods and those of [Khaled] to the detriment of [Mascot].

[Khaled] has taken [Mascot's] Mark without authorisation and has been offering similar product design, packaging, and branding, essentially creating a knockoff version to sell. This unauthorised copying may result in confusion to customers by offering a lower-quality imitation of our original product. For the same product and same mark, it is unusual that [Khaled] then filed the same trade mark in the registry and went on to sell it in the same marketplace. Additionally, [Khaled] has filed several trade marks which are identical to those marks owned by [Mascot].

As a consequence of the above knowledge, [Khaled's] behaviour in registering the mark, falls short of the standards of acceptable commercial behaviour meaning the application to register the mark was filed in bad faith as defined under S.3(6) of the UK Trade Marks Act 1994."

Was that an objective for the purposes of which the contested application could not be properly filed?

53. If Mascot substantiates its claims that Khaled knew of Mascot's use and deliberately chose the "OLDGITAMOL" mark with the intention of undermining the interests of Mascot, or third parties, bad faith may be established.

Was it established that the contested application was filed in pursuit of that objective?

54. Mascot's claim centres around Khaled's alleged knowledge of Mascot's use of "OLDGITAMOL". Firstly, the mere fact that Khaled knew that another party used the trade mark in the UK does not establish bad faith: *Lindt, Koton*. Secondly, and pertinently, the evidence does not support the claim that Khaled knew of Mascot's use; there is nothing in the evidence to prove this knowledge, only the suggestion by Mascot that because its products were available on Amazon in May 2023, by September 2023, Khaled must have been aware of Mascot's use. The evidence simply does not support that. I assessed Mascot's evidence of use in relation to goodwill under the section 5(4)(a) ground. In light of my finding of no goodwill, the evidence falls a long way short of establishing widespread use such that it must have come to

Khaled's notice. I am not prepared to infer such knowledge by Khaled on the basis of such small scale use by Mascot.

55. An allegation of bad faith is a serious allegation which must be distinctly proved (*Red Bull*) and, in my view, Mascot has not done so. Absent any evidence corroborating Mascot's claim that Khaled must have known of Mascot's use, Mascot has not shown a prima facie case of bad faith and the ground of opposition fails.

56. However, in case I am wrong and Mascot's claim is sufficient for raising a prima facie case for Khaled to answer, I will turn to his rebuttal of the bad faith claim. I will also deal with the other points raised by Mascot, specifically that Khaled: (a) must have known of Mascot's use of the mark because "OLDGITAMOL" is an unusual name and so it is unusual that Khaled applied for the same trade mark in relation to the same goods; (b) then used the trade mark application to oppose Mascot's application; and (c) has filed other trade marks identical to trade marks owned by Mascot.

57. I will not reproduce Khaled's entire counterstatement but will summarise the pertinent points. Khaled explains that his company (trading as either "Joyful Clan" or "Emperor Supplies") is in the business of selling satirical, prank and practical joke products that centre around fictitious medicinal products and lists its product range since 2022.¹³ Khaled emphasises that he had no knowledge of Mascot and that the filing of the application was an ordinary part of its business. Khaled's evidence demonstrates that products featuring 'portmanteaus' using a combination of pharmaceutical product names and rude words were available on Etsy and Amazon from October 2022 from the brand "Joyful Clan".¹⁴

58. In response to Khaled's evidence, Mascot filed evidence of Amazon listings of similar products ("portmanteau-based prank medicines"¹⁵) from third parties between January 2020 and December 2021¹⁶ bearing marks other than "OLDGITAOL". Mascot

¹³ Khaled's counterstatement at [8(b) and (c)].

¹⁴ SK1 and SK2.

¹⁵ SEJ WS2 at [3].

¹⁶ SEJ18.

asserts that this demonstrates Khaled's pattern of filing trade marks that were already in use by third parties.¹⁷

59. Similar to my reasoning in paragraphs 54 and 55 in relation to Khaled's knowledge of Mascot's use, the evidence provided by Mascot does not prove that Khaled was aware of the use of the 'portmanteaus' by third parties. As such, I am not prepared to make a finding that Mascot has demonstrated any particular pattern of behaviour by Khaled.

60. In respect of "OLDGITAMOL" being an unusual name, an application for an identical mark (which is invented) and identical goods, in the absence of a credible explanation, might be unlikely to be coincidental.¹⁸ However, Khaled has provided a plausible explanation in terms of "OLDGITAMOL" fitting within its wider business, and it is not enough to establish facts which are equally consistent with good faith as bad faith (*Red Bull*). For the same reason, Khaled relying upon the application to oppose Mascot's application is not bound to result in a finding of bad faith; it is consistent with a trade mark proprietor attempting to protect its rights.

61. On the balance of probabilities, it seems far more likely that the present circumstances indicate parties engaging in fair competition than Khaled's application having been made in bad faith.

Outcome

62. The claims under section 3(6) are dismissed.

63. The effect of this opposition is that Khaled's Oldgitamol Class 16 application may proceed to registration and, subsequently, remains a valid earlier mark for the purpose of the following three oppositions.

¹⁷ SEJ WS2 at [18].

¹⁸ *Sivaratnam v Maya Appliances PVT. Ltd*, BL O/0052/25.

Opposition no. 445479 against Mascot's Oldgitamins Class 16 application

Section 5(2)(b)

Statutory provisions

64. Sections 5(2)(b) and 5A of the Act state:

“5(2) A trade mark shall not be registered if because –

[...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

Relevant law

65. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; and

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods

66. The specifications of Mascot's Oldgitamins and Khaled's Oldgitamol Class 16 applications are identical, as follows:

Class 16: Cards; Christmas gift wrap; Gift wrap; Diaries; Pocket diaries; Gift wrapping paper; Greeting cards; Invitation cards; Invitations; Party invitations; Printed invitations; Notepads; Paper; Paper party bags; Paper bags; Paper boxes; Paper boxes for storing greeting cards; Paper pads; Pen and pencil boxes; Pen and pencil cases; Pen boxes; Pencil boxes; Pen sets; Pens; Pencils; Pencil sets; Postcard paper; Postcards; Printed cards; Thank you cards; Writing paper; Writing paper pads; Printed packaging materials of paper; Packaging materials; Gift packaging; Cardboard packaging; Paper bags for packaging; Origami folding paper; Gift boxes; Cardboard gift boxes; Paper gift boxes; Gift bags; Gift cards; Gift certificates; Printed paper invitations; Graphic prints.

The average consumer and the purchasing act

67. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

68. In *Iconix* (cited above), the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* EWCA Civ 262, where he pointed out that:

- (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
- (b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;
- (c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;
- (d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;
- (e) The average consumer's level of attention varies according to the category of goods or services in question; and
- (f) The average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

69. The average consumer of the parties' Class 16 goods is a member of the general public, who will, when selecting such goods, consider factors such as the aesthetic and suitability. The goods are purchased frequently at a fairly low cost and so I find that the average consumer would pay no more than a medium degree of attention to their selection.

70. The goods will be self-selected from the shelves of physical premises, such as retail stores, supermarkets or stationery stores, as well as their online or catalogue equivalents. Therefore, the visual considerations are dominant in the purchasing process, though I do not discount an aural element to the purchase where conversations with sales assistants take place.

Comparison of marks

71. It is clear from *Sabel* that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union ("CJEU") stated at paragraph 34 of its judgment in *Bimbo*, that:

“...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relevant weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

72. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

73. The marks to be compared are as follows:

Khaled's application	Mascot's application
Oldgitamol	Oldgitamins

74. "Oldgitamol" is one, invented word, though consumers will likely recognise the words "old" and "git" subsumed within the mark. Whilst some consumers might associate "-amol" with the end of the word "paracetamol" as suggested by the parties, it is unlikely that the vast majority of consumers will isolate the ending "-amol" and attribute it any particular meaning. Regardless, the overall impression lies in the word as a whole.

75. "Oldgitamins" is one, invented word, though, again, consumers will likely recognise the words "old" and "git" subsumed within the mark. I am of the view that consumers will recognise "-itamins" within the mark and assume part of the ordinary word "vitamins", has been conjoined with "oldgit". However, the overall impression lies in the word as a whole.

76. Visually, the marks coincide in their first eight letters, "Oldgitam" and differ in their final two letters (in Khaled's mark) and three letters (in Mascot's mark). Given the proportion of the marks that appear identically, I find them visually similar to a high degree.

77. Both marks comprise four syllables, the first three being identical and the fourth being aurally different. Bearing in mind that consumers usually tend to focus on the beginning of marks,¹⁹ I find them to be aurally similar to a high degree.

78. Whilst invented words often do not portray a clear concept, the "Oldgit" element common to both marks will be noticed and understood as a slang term used as a mild insult aimed at an older person. The endings of the marks create conceptual differences, "amol" having no particular meaning and "itamins" likely grasped as a

¹⁹ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

misspelling of “vitamins”. When considering the marks as wholes, they will be remembered by the concept that is clear and immediately graspable:²⁰ ‘old git’, though the different endings of the marks do detract to some degree from the shared element. Overall, I find a medium degree of conceptual similarity between the marks.

Distinctive character of the earlier mark

79. In *Lloyd Schuhfabrik Meyer* the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

80. There is very little in the way of evidence of use of Khaled’s Oldgitamol Class 16 application. There are no sales figures, no details on market share or the amount spent on promoting the mark and I cannot determine how intensive or geographically

²⁰ *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

widespread the use has been. As such, the mark's distinctiveness has not been enhanced through use and I have only the inherent position to consider.

81. Oldgitamol is not an ordinary dictionary word: as a whole it is invented, though the words "old" and "git" will be recognised. The mark is neither descriptive nor allusive for the goods at issue and I consider it has a medium to high degree of inherent distinctiveness.

Likelihood of confusion

82. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he/her has retained in his/her mind.

83. I have found the parties marks to be visually and aurally similar to a high degree and conceptually similar to a medium degree. The goods are identical and I have identified the average consumer of them to be a member of the general public who pays no more than a medium degree of attention to a mainly visual purchase. I have found the earlier mark to possess a medium to high degree of inherent distinctive character.

84. Bearing in mind the high visual and aural similarity between the marks, the shared "old git" concept, and the identical goods, I am of the view that the average consumer

will directly confuse one mark for the other, noticing the identical beginning of the marks and overlooking or misremembering the final two or three letters.

85. For completeness, I will also consider indirect confusion, which was described in the following terms by Iain Purvis KC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc.*²¹

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand

²¹ BL O/375/10.

or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI”, etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

86. The examples given by Mr Purvis are not exhaustive. Rather, they were intended to be illustrative of the general approach.²²

87. If I am wrong on my direct confusion finding and consumers notice the difference in the marks’ endings, even though “amol” in “Oldgitamol” has no clear concept, in my view, use of the phrase “old git” on identical goods will lead consumers to believe both “Oldgitamol” and “Oldgitamins” are trade marks from the same or related undertakings. I find there to be a likelihood of indirect confusion.

Outcome

88. Khaled’s opposition under section 5(2)(b) succeeds in full and, subject to appeal, Mascot’s Oldgitamins Class 16 application is refused in its entirety.

Opposition no. 445480 against Mascot’s Oldgitamol Class 16 application

Section 5(1)

Statutory provisions

89. Section 5(1) of the Act states:

“5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are

²² See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17 at [81] to [82].

identical with the goods or services for which the earlier trade mark is protected.”

Assessment

90. Khaled’s Oldgitamol Class 16 application and Mascot’s Oldgitamol Class 16 application are both for the trade mark “Oldgitamol”. The trade marks are clearly identical. The respective specifications are identical, as follows:

Class 16: Cards; Christmas gift wrap; Gift wrap; Diaries; Pocket diaries; Gift wrapping paper; Greeting cards; Invitation cards; Invitations; Party invitations; Printed invitations; Notepads; Paper; Paper party bags; Paper bags; Paper boxes; Paper boxes for storing greeting cards; Paper pads; Pen and pencil boxes; Pen and pencil cases; Pen boxes; Pencil boxes; Pen sets; Pens; Pencils; Pencil sets; Postcard paper; Postcards; Printed cards; Thank you cards; Writing paper; Writing paper pads; Printed packaging materials of paper; Packaging materials; Gift packaging; Cardboard packaging; Paper bags for packaging; Origami folding paper; Gift boxes; Cardboard gift boxes; Paper gift boxes; Gift bags; Gift cards; Gift certificates; Printed paper invitations; Graphic prints.

Outcome

91. In light of the identical trade marks and identical goods, Khaled’s opposition under section 5(1) succeeds in full. Subject to appeal, Mascot’s Oldgitamol Class 16 application is refused in its entirety.

Opposition no. 445481 against Mascot’s Oldgitamol Class 30 application

Section 5(2)(a)

Statutory provisions

92. Sections 5(2)(a) and 5A of the Act state:

“5(2) A trade mark shall not be registered if because –

(a) it is identical to an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected,

[...]

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

Relevant case law

93. The *Iconix* principles set out at paragraph 65 of this decision apply equally in this opposition.

Comparison of marks

94. It is self-evident that the marks are identical, both being “Oldgitamol”.

Comparison of goods

95. It is settled case law that I must make my comparison of the goods on the basis of all relevant factors. These include the nature of the goods, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited* (*TREAT Trade*

Mark) [1996] RPC 281. As the General Court said in *Boston Scientific Ltd v OHIM*,²³ goods are complementary when:

“...there is close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

96. The parties' specifications are listed in the table below.

Khaled's Oldgitamol Class 16 application	Mascot's Oldgitamol Class 30 application
Class 16: <i>Cards; Christmas gift wrap; Gift wrap; Diaries; Pocket diaries; Gift wrapping paper; Greeting cards; Invitation cards; Invitations; Party invitations; Printed invitations; Notepads; Paper; Paper party bags; Paper bags; Paper boxes; Paper boxes for storing greeting cards; Paper pads; Pen and pencil boxes; Pen and pencil cases; Pen boxes; Pencil boxes; Pen sets; Pens; Pencils; Pencil sets; Postcard paper; Postcards; Printed cards; Thank you cards; Writing paper; Writing paper pads; Printed packaging materials of paper; Packaging materials; Gift packaging; Cardboard packaging; Paper bags for packaging; Origami folding paper; Gift boxes; Cardboard gift boxes; Paper gift boxes; Gift bags; Gift cards; Gift</i>	Class 30: <i>Sweets; Candies [sweets]; Sweets [candy]; Chocolate sweets; Sugar-free sweets; Caramels [sweets]; Sugarfree sweets; Sugarless sweets; Peppermint sweets; Sweets (Peppermint -); Sweets (Non-medicated -) being acidulated caramel sweets; Gum sweets; Sweetmeats being candies; Boiled sweets; Sweetmeats [candy]; Non-medicated sweets; Sweets (Non-medicated -); Sweets (Non-medicated -) in the nature of sugar confectionery; Sweetmeats [candy] being flavoured with fruit; Xylitol-sweetened sweets; Foamed sugar sweets; Sweets (Non-medicated -) in the nature of chocolate eclairs; Sweets (Non-medicated -) in the nature of toffees; Peppermint sweets [other than for medicinal use]; Gum sweets (Non-medicated -); Mint-based</i>

²³ Case T-325/06.

certificates; Printed paper invitations; Graphic prints.	sweets; Sweets (candy), candy bars and chewing gum; Chocolate candies; Chewing sweets (Non-medicated -); Mint flavoured sweets (Non-medicated -); Sweets (Non-medicated -) in the nature of caramels; Lollipops [confectionery]; Candies; Sweetmeats [candy] containing fruit; Sweets (Non-medicated -) being acidulated; Caramels [candies]; Sweets (Non-medicated -) in the nature of fudge; Sherbets [confectionery]; Sugarless candies; Chocolate-coated sugar confectionery; Sweets (Non-medicated -) in the nature of nougat; Chocolate confections; Chocolate confectionery; Chocolate candy with fillings; Chocolates; Sugar candy [for food]; Sugar confectionery; Flavoured sugar confectionery; Chewing sweets (Non-medicated -) having liquid fruit fillings; Jellies (Fruit -) [confectionery]; Fruit jellies [confectionery]; Sugar candies (Non-medicated -); Sugar-free mint candies; Fruit confectionery; Chocolate confectionery; Non-medicated confectionery candy; Caramels [candy]; Mint based sweets [non-medicated]; Sweets (Non-medicated -) being honey based; Sherbet [confectionery]; Candy [sugar]; Chocolate confectionery containing pralines; Pastilles [confectionery]; Chocolate confectionery products; Confectionery chocolate
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	<i>products; Gummy candies; Confectionery; Non-medicated chocolate confectionery; Truffles [confectionery]; Peppermint for confectionery; Milk chocolates; Candy coated confections; Candy; Mints [candies, non-medicated]; Candy mints; Chocolate confectionery having a praline flavour; Toffees; Breath-freshening chewing gum; Bubble gum; Bubble gum [confectionery]; Chewing gum; Chewing gums; Sugar-free chewing gum; Sugarfree chewing gum; Sugarless chewing gum.</i>
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97. Having considered the relevant factors set out in the case law above I find no obvious similarity between any of the parties goods.

98. In accordance with *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, if there is no similarity between goods, there is no likelihood of confusion to be considered under section 5(2).

Outcome

99. Khaled's opposition under section 5(2)(a) fails and, subject to appeal, Mascot's Oldgitamol Class 30 application will proceed to registration; accordingly, it qualifies as an earlier mark for the purpose of the following opposition.

Opposition no. 446219 against Khaled's Oldgitamol Class 30 application

Sections 5(1) and 5(2)(a)

Statutory provisions and relevant case law

100. Sections 5(1), 5(2)(a) and 5A have been set out earlier in this decision, as has the relevant case law (*Iconix*).

Comparison of marks

101. Mascot's and Khaled's respective Oldgitamol Class 30 applications are for identical trade marks: "Oldgitamol".

Comparison of goods

102. Khaled's and Mascot's Class 30 specifications are listed in paragraphs 2 and 7, respectively.

103. I bear in mind that even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa).²⁴ On the basis that all of Khaled's Class 30 goods are either worded identically to Mascot's Class 30 goods, or fall within the broader terms *candy*, *sweets* or *confectionery* (for the avoidance of doubt, I consider chewing gum to be a type of confectionery), the parties goods are identical.

Outcome

104. In light of the identical trade marks and identical goods, Mascot's opposition under section 5(1) succeeds in full. Subject to appeal, Khaled's Oldgitamol Class 30 application is refused in its entirety.

FINDINGS

105. I will now summarise the entirety of my findings in this decision.

²⁴ *Gérard Meric v OHIM*, Case T-133/05.

(i) Opposition no. 444935 has failed and Khaled's Oldgitamol Class 16 application under no. UK00003953437 will proceed to registration.

(ii) Opposition no. 445479 is successful and Mascot's Oldgitamins Class 16 application under no. UK00003966592 is refused in its entirety.

(iii) Opposition no. 445480 is successful and Mascot's Oldgitamol Class 16 application under no. UK00003966590 is refused in its entirety.

(iv) Opposition no. 445481 has failed and Mascot's Oldgitamol Class 30 application under no. UK00003968182 will proceed to registration.

(v) Opposition no. 446219 is successful and Khaled's Oldgitamol Class 30 application under no. UK00003976381 is refused in its entirety.

COSTS

106. Khaled succeeded in three oppositions and Mascot in two. Each party has achieved a roughly equal measure of success in these consolidated proceedings. As such, I order each party to bear its own costs.

Dated this 8th day of September 2026

MRS E FISHER

For the Registrar